

1 Remarks

2 Amendments to the Claims:

3 Claims 1, 2, 3, 7, and 8 have been amended as shown in the above detailed  
4 listing of claims. Specifically, claim 1 has been amended by adding thereto at least one  
5 element from claim 4 which has been canceled. Claim 2 has been amended by  
6 canceling redundant language and by changing the word "media" to the word "booklet"  
7 for consistency with claim 1. Claim 3 has been amended by changing the word "media"  
8 to the word "booklet" for consistency with claim 1.

9 Claim 7 has been amended by deleting the element, "printing the postage on the  
10 booklet." This amendment makes claim 7 no broader than the original claim 1. Claim 8  
11 has been amended by adding the term "finish" in order to make the terminology of that  
12 claim more consistent with the terminology of claims 9, 10, and 11. Claim 8 has also  
13 been amended by deleting the term "etc." from line 4 of that claim.

14 Objections to the Claims:

15 Claims 8-10 have been objected to because of the term "etc." appearing at the  
16 end of line 4 of claim 8.

17 Claim 8 has been amended to delete the term "etc." from line 4 of that claim as  
18 shown hereinabove.

19 Rejection of Claims Under 35 U.S.C. 101:

20 Claims 1-11 have been rejected under 35 U.S.C. 101 "because the claimed  
21 invention is directed toward non-statutory subject matter." The reason provided by the  
22 Examiner for these rejections is that, "a method of distributing literature in the form of a  
23 booklet which includes a plurality of sheets of media (with respect to claims 1 and 7)  
24 does not include any computer implementation or any other technology employed."

25 The MPEP states that, "[t]he primary object of the examination of an application  
is to determine whether or not the claims are patentable over the prior art . . . . Where a  
major technical rejection is proper (e.g., lack of proper disclosure, undue breadth, utility,  
etc.) such rejection should be stated with a full development of the reasons rather than  
by a mere conclusion coupled with some stereotyped expression." (MPEP 706.03).  
Furthermore, the MPEP directs that, "Office personnel should state all reasons and  
bases for rejecting claims in the first Office action," . . . and that "[d]eficiencies should be

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1 explained clearly, particularly when they serve as a basis for a rejection. Whenever  
2 practicable, Office personnel should indicate how rejections may be overcome and how  
3 problems may be resolved." (MPEP 2106 II).

4 The Applicant respectfully asserts that the reason provided by the Examiner (i.e.  
5 that the claims "[do] not include any computer implementation or any other technology  
6 employed") is not specific enough for the Applicant to understand why the rejections  
7 have been made because there has been no legal precedent provided which supports  
8 that reason. Although the Examiner provides a discussion of various case law, the  
9 Applicant cannot find in that case law the requirement that a claim include "computer  
10 implementation or any other technology employed" in order to be directed to statutory  
11 subject matter.

12 That is, the Applicant respectfully asserts that the rejections of claims 1-11 under  
13 35 U.S.C. 101 are improper because the question of whether or not a claim includes  
14 "any computer implementation or any other technology employed" is not the proper basis  
15 on which to determine whether that claim is directed to statutory subject matter.

16 As is generally accepted, and "[a]s the Supreme Court has held, Congress chose  
17 the expansive language of 35 U.S.C. 101 so as to include 'anything under the sun that is  
18 made by man,'" and that, "[i]n choosing such expansive terms as 'manufacture' and  
19 'composition of matter,' modified by the comprehensive 'any,' the Congress plainly  
20 contemplated that the patent laws would be given wide scope." (MPEP 2106(IV)(A),  
21 quoting *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09, 206 USPQ 193, 197 (1980)).

22 It is also generally accepted that "35 U.S.C. 101 defines four categories of  
23 inventions that Congress deemed to be the appropriate subject matter of a patent;  
24 namely, processes, machines, manufactures and compositions of matter." (MPEP  
25 2106(IV)(A). It is furthermore generally accepted that, "[t]he term 'process' means  
process, art, or method . . ." (MPEP 2106(IV)(A), quoting 35 U.S.C. 100(b)(emphasis  
added)). The only other requirement for granting a patent to an invention under 35  
U.S.C. 101 is that "the subject matter sought to be patented be a 'useful' invention."  
(MPEP 2106(IV)(A)).

Therefore, "a complete definition of the scope of 35 U.S.C. 101, reflecting  
Congressional intent, is that any new and useful process, machine, manufacture or  
composition of matter under the sun that is made by man is the proper subject matter of  
a patent. (MPEP 2106(IV)(A). Or, stated in another way, "[s]ubject matter not within one  
of the four statutory invention categories or which is not 'useful' in a patent sense is,

1 accordingly, not eligible to be patented.” (*Id.*). In other words, “[t]he subject matter  
2 courts have found to be outside the four statutory categories of invention is limited to  
3 abstract ideas, laws of nature and natural phenomena.” (*Id.*).

4 Clearly, the Applicant’s claims 1-11 describe one or more useful methods and  
5 thus fall into at least the statutory category of “process.” Stated in a contrary manner,  
6 the Applicant’s claims 1-11 clearly do not fall into the categories of “abstract ideas, laws  
7 of nature and natural phenomena.”

8 In regard to the Applicant’s claim 1, which has been amended as shown  
9 hereinabove, that claim is a method and thus falls into one of the four general statutory  
10 categories. Claim 1 recites the elements of:

- 11 1) estimating the weight of each sheet of media;
- 12 2) multiplying the number of sheets of media in the booklet by the estimated  
13 weight of each sheet of media to calculate the total weight of the booklet; and,
- 14 3) calculating postage for the booklet based on the total weight of the  
15 booklet.

16 The Applicant asserts that claim 1 is directed toward statutory subject matter  
17 because, among other reasons, it is a useful method which results in the calculation of  
18 postage for a booklet. Stated another way, the Applicant asserts that claim 1 is not  
19 directed toward non-statutory subject matter because calculation of postage for a  
20 booklet is not a law of nature, or a natural phenomenon, or an abstract idea. Rather, as  
21 is stated above, calculation of postage for a booklet is part of a useful method which falls  
22 within statutory subject matter.

23 Moreover, a claim “may . . . be statutory if it is limited by the language of the claim  
24 to a practical application within the technological arts.” (MPEP 2106 (IV)(B)(2)(b)(i)).  
25 The Applicant asserts that the subject matter of claim 1 is statutory, among other  
reasons, because claim 1 is limited by the language of that claim to a practical  
application within the technological arts, wherein that the claim is limited to the practical  
application of, “calculating postage for the booklet . . . .” The Applicant asserts that  
calculating postage for a booklet is clearly a practical application within the technological  
arts.

Therefore, the Applicant respectfully requests that the rejection of claim 1 under  
35 U.S.C. be withdrawn.

In regard to claims 2 and 3, those claims depend from claim 1. Therefore, the  
Applicant contends that the subject matter of those claims is statutory for the reasons set

1 forth above with respect to claim 1. Accordingly, the Applicant respectfully requests that  
2 the rejections of claims 2 and 3 under 35 U.S.C. 101 be withdrawn.

3 In regard to claims 4-6, those claims have been canceled herein and the  
4 rejections of those claims are, therefore, now moot.

5 In regard to claim 7, that claim contains elements similar to those of claim 1.  
6 Specifically, claim 7 recites the element, "calculating a postage to be paid to a delivery  
7 service to deliver the booklet to an individual, wherein the postage is calculated based  
8 on the weight of the booklet." Therefore, the Applicant asserts that the subject matter of  
9 claim 7 is statutory for the reasons set forth above with respect to claim 1.

10 In regard to claims 8-11, those claims depend from claim 8. Therefore, the  
11 Applicant contends that the subject matter of those claims is statutory for the reasons set  
12 forth above with respect to claim 1. Accordingly, the Applicant respectfully requests that  
13 the rejections of claims 8-11 under 35 U.S.C. 101 be withdrawn.

14 Rejection of Claims Under 35 U.S.C. 102:

15 Claims 1-6 have been rejected under 35 U.S.C. 102(e) as being anticipated by  
16 U.S. Patent 5,134,568 to Tonkin (hereinafter referred to as "Tonkin"). Specifically, with  
17 respect to claim 1, the Examiner states that "Tonkin discloses a method comprising:

18 counting the number of sheets of media in the booklet (col. 9, line 52-col. 10,  
19 line 3);

20 estimating the weight of each sheet of media (Id.); and

21 multiplying the number of sheets of media in the booklet by the estimated weight  
22 of each sheet of media to calculate the total weight of the media (see generally cols.  
23 9-10)."

24 The Examiner, with respect to claims 2-6 states that, "Tonkin further discloses the  
25 method comprising:

estimating the weight of the binding materials or cover (col. 8, line 49-col. 10,  
line 3; see Figs. 5A-9); and

adding the weight of the binding materials and the total weight of the media (Id.);

calculating postage for the booklet based on the total weight of the media  
(including additional materials)(see Fig. 9 and col. 13, line 26-col. 14, line 34)."

A generally accepted standard under which an anticipation rejection can be made  
under 35 U.S.C. 102 is found in the MPEP which states, "A claim is anticipated only if  
each and every element as set forth in the claim is found, either expressly or inherently

1 described, in a single prior art reference." (MPEP 2131, quoting *Verdegaal Bros. v.*  
2 *Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).  
3 Or, in other words, "[t]he identical invention must be shown in as complete detail as is  
4 contained in the . . . claim." (*Id.*, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d  
1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)).

5 As is shown hereinabove, the Applicant has amended claim 1 to now include at  
6 least the following elements:

- 7 1) counting the number of sheets of media in the booklet;
- 8 2) estimating the weight of each sheet of media;
- 9 3) multiplying the number of sheets of media in the booklet by the estimated  
weight of each sheet of media to calculate the total weight of the booklet; and,
- 10 4) calculating postage for the booklet based on the total weight of the  
booklet.

11 The Applicant asserts that at least the fourth element of "calculating postage for  
12 the booklet based on the total weight of the booklet" is not disclosed by Tonkin, and that,  
13 therefore, Tonkin does not anticipate claim 1.

14 As has already been noted above, the Examiner contends that Tonkin discloses  
15 "calculating postage for the booklet based on the total weight of the media (including  
additional materials)" at col. 13, line 26 through col. 14, line 34, and in Fig. 9).

16 The Applicant respectfully disagrees with the Examiner's interpretation of Tonkin.  
17 The Applicant has reviewed the cited passage of Tonkin carefully and cannot find a  
single occurrence of the term "postage," or its equivalent, therein. Furthermore, the  
18 Applicant cannot find a single occurrence of the term "postage," or its equivalent,  
19 anywhere in Tonkin, including the drawings.

20 A relevant portion of Tonkin at col. 13, lines 52-64 is quoted below:

21 "In step 212 (shown in Fig. 3), the order information is automatically  
22 evaluated and routed to one of the production locations. Preferably,  
23 processing facility 60 has a stored database with information regarding the  
capabilities and geographic location of each of the production locations.  
24 In the preferred embodiment, geographic location is taken into account by  
25 comparing distances from the document production locations to the  
recipient's location. Furthermore, in certain embodiments of the invention,  
it might be desirable to estimate the geographic distance based on zip  
code. Accordingly, the document order can be routed to the location

1 nearest to the recipient's location that is appropriate for processing the  
2 order."

3 From the above quoted passage of Tonkin, it is clear that, at most, Tonkin  
4 discloses a method of electronically routing an order to be printed to a printing facility  
5 that is nearest to the recipient's location, wherein such routing is based on zip code.  
6 That is, Tonkin, at most, discloses a method of sending an order, in electronic format, to  
7 a facility that is capable of printing the order and which facility is determined to be the  
8 closest facility to the location of the recipient of the order based on zip code.

9 The Applicant asserts that such disclosure is not equivalent to "calculating  
10 postage for the booklet based on the total weight of the media." That is, Tonkin does not  
11 disclose "calculating postage for the booklet based on the total weight of the media" and  
12 therefore does not anticipate the Applicant's claim 1 as amended herein.

13 In regard to the Applicant's claims 2 and 3, those claims depend from claim 1 and  
14 therefore include at least the elements of claim 1. Accordingly, claims 2 and 3 are not  
15 anticipated by Tonkin for the reasons set forth above with respect to claim 1.

16 In regard to the Applicant's claims 4-6, those claims have been canceled and the  
17 rejections with respect thereto are now moot.

18 Accordingly, the Applicant respectfully requests that the rejections of claims 1-3  
19 under 35 U.S.C. 102 be withdrawn and that those claims be allowed.

20 Rejection of Claims Under 35 U.S.C. 103:

21 Claims 7-11 have been rejected under 35 U.S.C. 103(a) as being unpatentable  
22 over Tonkin in view of EP 0621563 A1 (hereinafter referred to as "EP"). Specifically, the  
23 Examiner states that, "Tonkin discloses a method comprising: . . . calculating a postage  
24 for media based on the weight of the booklet."

25 The Examiner states further that, "Tonkin does not expressly disclose the method  
including printing the postage on the booklet," but that, "EP teaches, for system and  
method preparing items for mailing, that the system prints the postage on the booklet,  
wherein the postage amount is calculated by the known weights of the selected items."

A generally accepted standard for rejecting a claim under obviousness is that in  
order "[t]o establish a *prima facie* case of obviousness . . . the prior art reference (or  
references when combined) must teach or suggest all the claim limitations." (MPEP  
2142).

1 The Applicant asserts that the Examiner has not established a *prima facie* case  
2 of obviousness in regard to the Applicant's claim 7, because the prior art references do  
3 not teach or suggest all of the claim limitations.

4 Specifically, as is explained above with respect to claim 1, the Applicant asserts  
5 that Tonkin does not disclose the element "calculating a postage for media based on the  
6 weight of the booklet" as is recited in the Applicant's claim 7. EP does not cure this  
7 deficiency, as EP also does not disclose the element, "calculating a postage for media  
8 based on the weight of the booklet". Because the prior art references do not disclose  
9 "calculating a postage for media based on the weight of the booklet," as does the  
10 Applicant's claim 7, then it follows that the Applicant's claim 7 is not obvious in view of  
11 the cited prior art references.

12 In regard to the Applicant's claims 8-11, those claims depend from claim 7 and,  
13 therefore, claims 8-11 contain at least the elements of claim 7. Thus, the Applicant  
14 contends that claims 8-11 are not obvious in view of the cited prior art references  
15 because of the reasoning set forth above in regard to claim 7.

16 Accordingly, the Applicant respectfully requests that the rejections of claims 7-11  
17 under 35 U.S.C. 103 be withdrawn and that those claims be allowed.

#### 18 Summary

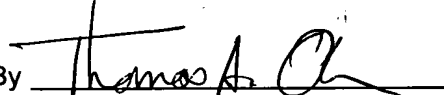
19 The Applicant believes that this response constitutes a full and complete reply to  
20 the Office action, and the Applicant furthermore requests timely allowance of claims 1-3  
21 and 7-11. The below-signed attorney respectfully requests that, in the event that the  
22 next Office action is anything other than a Notice of Allowance for claims 1-3 and 7-11,  
23 the Examiner call him before issuing the action.

24 Respectfully submitted,

25 Carl S. Chow

Date: February 24, 2004

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